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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,973	10/31/2003	Massimo Giannozzi	3816-S8	8977

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EXAMINER

KOEHLER, ROBERT R

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,973	GIANNOZZI, MASSIMO	
	Examiner	Art Unit	
	Robert R. Koehler	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 31, 2003 (Prel. Amdt.).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-18 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

RRK
3-10-05

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 11, the subject matter of a specific cobalt-base alloy composition defined by the actual mass of each element in the alloy and having the alloying elements "Cr, W, Si, C, Ni, Fe, Mn, Co, Mo, and Other" cannot be found in the specification. See Example 1 on page 13 of the specification.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is rejected as being vague and indefinite because the weight percentage of Cr in the claimed cobalt-base alloy composition lies outside of the Cr elemental range presented in claim 9. Independent claim 9 requires a Cr elemental range of 28 to 32 weight percent, but claim 10 only specifies the actual mass of Cr that is present in the claimed Co-base alloy composition. The Examiner notes that the sum of all alloying element weights, including impurities, is 89.6 grams, but the claimed weight percent of Cr is greater than 32 weight percent ($30 \text{ g}/89.6 \text{ g} = \text{approx. } 33.5 \text{ weight percent}$). Hence, the claimed Co-base alloy composition is vague and indefinite because the amount of chromium (expressed as weight percent) in the alloy lies outside of the Cr elemental range presented in claim 9.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is rejected as being vague and indefinite because the actual weight of cobalt in the claimed Co-base alloy composition has not been stated. The claim states that cobalt constitutes the "balance" of the claimed alloy composition, but it is impossible to know the "balance" amount for cobalt when the specific alloy composition has been defined by the actual weights of all alloying elements. The Examiner notes that the sum of all alloying element weights (excluding Co) is 41.35 g, but the claimed alloy composition is vague and indefinite because the claim does not provide any indication of the actual amount of cobalt contained in the alloy.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3, 4, 6, 9 to 12, and 15 to 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan Patent Application No. 11-336502 (Japan '502).

Japan '502 discloses a method of providing an improved anti-wear contact surface for moving turbine blades by welding a contact surface onto the appropriate regions of a turbine blade. The welded contact surface can have a thickness of approximately 1 mm; see page 2 of the computer translation of the "Detailed Description." According to the computer translation of the "Detailed Description" and the English-language translation of the abstract (Derwent),

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Japan '502 discloses cobalt-base alloy compositions having the same alloying elements (Cr, W, Fe, Mo, Ni, C, Si, and Mn) as claimed by the applicant with alloy elemental ranges that overlap applicant's claimed alloy elemental range limits or claimed Co-base alloy compositions. Prior art which teaches a range within, overlapping, or touching the claimed range anticipates if the prior art range discloses the claimed range with sufficient specificity. See MPEP 2131.03 and *Ex parte Lee*, 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993).

2. Claims 9 to 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by "Material Safety Data Sheet - Stellite Tips" (6 sheets).

The "Material Safety Data Sheet - Stellite Tips" (MSDS - Stellite) contains extensive information about cobalt-base alloys including alloy compositions under the trade name "Stellite." The MSDS - Stellite publication discloses cobalt-base alloy compositions having the same alloying elements (C, Co, Cr, Fe, Mn, Mo, Ni, Si, and W) as claimed by the applicant with alloy elemental ranges that overlap applicant's claimed alloy elemental range limits or claimed Co-base alloy compositions. See Section 2, "Percentage of Hazardous Ingredients In Various Alloys", on pages 1 and 2 of the MSDS - Stellite publication. Prior art which teaches a range within, overlapping, or touching the claimed range anticipates if the prior art range discloses the claimed range with sufficient specificity. See MPEP 2131.03 and *Ex parte Lee*, 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993).

3. Claims 9 to 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,966,422 (Kelley).

Kelley discloses cobalt-base alloy compositions having the same alloying elements (Cr, W, C, Mo, Ni, Si, Fe, and Mn) as claimed by the applicant with alloy elemental ranges that overlap applicant's claimed alloy elemental range limits or claimed Co-base alloy compositions. See lines 11 to 30 in column 1. Prior art which teaches a range within, overlapping, or touching

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the claimed range anticipates if the prior art range discloses the claimed range with sufficient specificity. See MPEP 2131.03 and *Ex parte Lee*, 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 9 and 15 to 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 11 and 16 to 19 of copending Application No. 10/670,121 (Giannozzi). Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a method for the treatment of organs subject to erosion by liquids comprising the application of a cobalt-base alloy on the surface of the organ to form an anti-corrosion layer wherein the claimed cobalt-base alloy compositions have identical alloying elements (Cr, W, Si, C, Ni, Fe, Mn, Mo, and Co) with alloy elemental range limits that overlap or meet (touch). Although both sets of claims do not contain identical alloy elemental ranges for the claimed cobalt-base alloy compositions, it would have been obvious to a person skilled in the art of cobalt-base alloys and cobalt-base metal coatings to select those portions of the alloy elemental ranges that overlap or meet (touch) and arrive at the same cobalt-base alloys or cobalt-base coating compositions which are utilized in the claimed method. A skilled person would have been motivated to rely on the claimed subject matter contained in Serial No. 10/670,121 and arrive at applicant's claimed method and claimed cobalt-base alloy compositions because the

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'121 patent application claims are directed toward the same method of coating a metallic substrate with a cobalt-base alloy and the same cobalt-base alloy compositions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The Examiner believes that the prior art does not teach, suggest, or disclose applicant's claimed cobalt-base alloy composition which contains specific amounts of Cr, W, Si, C, Ni, Fe, Mn, Mo, and Co. This specific cobalt-base alloy contains at least one alloying element having a concentration value that clearly lies outside of the alloy elemental ranges taught by the cited prior art.

Conclusion

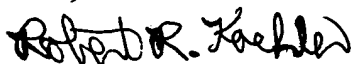
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Robert Koehler whose telephone number is **(571) 272-1536**. The Examiner can normally be reached on Tuesday to Friday from 9:30 AM to 7:00 PM. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Deborah Jones, can be reached on **(571) 272-1535**. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for

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unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Robert R. Koehler".

ROBERT R. KOEHLER
PRIMARY EXAMINER

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March 10, 2005